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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,636	02/02/2004	Jurg Rehbein	7299-009	1586
20583	7590	06/30/2006	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			CHENG, JOE H	
			ART UNIT	PAPER NUMBER
			3715	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/770,636

Applicant(s)

REHBEIN ET AL.

Examiner

Joe H. Cheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon. The recitation therein is unclear and confusing, because the description of Figs. 1-9 is missing. In addition, the description of the reference numbers must be directed to the same structural elements or features throughout the specification. Further, the status of the cross-reference to the related application should be updated. Clarification is required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 21-35 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed structural method steps cannot perform the function for enabling communication between first and second parties, because no communication steps has been clearly recited thereto (as per claims 21-29) or communicating between the different members of the first party user only (as per claims 30-35).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-10, 12-17 and are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 10-21 of U.S. Patent No. 6,685,188

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B2 (hereinafter as Rehbein et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the patented claims and the proposed application claims are minor, obvious and board version of the patented claims and all proposed claims are obvious and included in the patented claims, and any infringement over the patents would also infringe over the instant claims. It is noted that the recitation of “enabling communication between at least one first party and at least one second part” (as per claim 1), “interactive hardware” (as per claim 8), and “convert the entered second monetary amount into an amount corresponding to a first party currency” (as per claim 16) are the obvious alternative languages since these merely describe “the method of performing a transaction between first and second transaction parties” (claim 1 of Rehbein et al), “an electronic device comprising at least one surface on which information may be entered into the electronic device by the stylus” (claim 20 of Rehbein et al), and “calculating and displaying an exchange rate and currency conversion for currencies of at least two different countries” (claim 13 of Rehbein et al) respectively in boarder terms and the differences are the use of alternate terminology which are obvious and do not change the scope of the proposed claims. Hence, the instant claim does not differ from the scope of the patented claims 1-7, 10-21 of Rehbein et al. In 214 USPQ 761, *In re Van Ornum* and *Stang*, broad claim in the continuing application were held to be obvious double patenting over previously narrow claims.

8. Claims 21-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 10-21 of U.S. Patent No. 6,685,188 B2 (hereinafter as Rehbein et al) in view of Barnes et al (U.S. Pat. No. 5,974,372). It is noted that

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the teaching of Rehbein et al does not specifically disclose the user profile (as per claim 21) and the navigational system (as per claim 28) as required. However, the teaching of Barnes et al teaches that such features of the user profile (Fig2. 20-22) and the navigational system (Figs. 13, 17-19 and 23-26) are old and well known, and are considered an arbitrary obvious design choice. Hence, it would have been obvious to one of ordinary skill in the art to modify the method for enabling communication between first and second parties of Rehbein et al with the features of the user profile and the navigational system as taught by Barnes et al as both Rehbein et al and Barnes et al are directed to the method of enabling communication between first and second parties, so as to provide the user's information and to allow to select the stored information to assist the need party.

9. Claims 30-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 10-21 of U.S. Patent No. 6,685,188 B2 (hereinafter as Rehbein et al) in view of Barnes et al (U.S. Pat. No. 5,974,372) and further in view of Yukimachi et al (U.S. Pub. No. 2002/0169691 A1). It is noted that the teaching of Rehbein et al and Barnes et al do not explicitly disclose the first party to communicate with another first party (as per claim 30), or wired transmission (as per claim 36) as required. However, the teaching of Yukimachi et al teaches the features of the first party to communicate with another first party (A), or wired transmission (Fig. 1). Hence, it would have been obvious to one of ordinary skill in the art to modify the method for enabling communication between first and second parties of Rehbein et al and Barnes et al with the features of the first party to communicate with another first party (A), or wired transmission as taught by Yukimachi et al as

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both Rehbein et al, Barnes et al and Yukimachi et al are directed to the method of enabling communication between first and second parties, so as to provide the different members of the first party to exchange information and to communicate with the second party through the wired transmission.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Miyao et al (U.S. Pat. No. 4,774,666) teaches the translating apparatus having the synonym display device for displaying synonyms related to a certain translated terms in a translated sentence, and the replacing arrangement for replacing the certain translated term with an appropriate synonym selected among the synonyms displayed by the display device.

Hugentobler (U.S. Pat. No. 5,576,953 B1) discloses the portable electronic translating device.

Steele et al (U.S. Pat. No. 5,742,779) discloses the language-oriented information communicating with the user by using the sized icons, text and audio on the dynamic graphic display of the computer.

Baskerville (U.S. Pat. No. 5,865,625) discloses the electronic flash card apparatus for allowing the user to memorize randomly chosen facts relating to various topics.

Sameth et al (U.S. Pat. No. 5,882,202) teaches the method and system for aiding foreign language instruction.

Tamura et al (U.S. Pat. No. 5,885,081) discloses the method and system for conversion between linguistically significant symbol sequences with display of support information that a user may desire to reference for the conversion result, so that permitting the user to voluntarily reference one of the support information and the spelling variations for a plurality of candidates any time when desired..

Brown (U.S. Pub. No. 2002/0124109 A1)

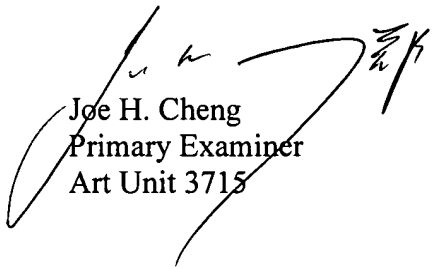
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teaches the system and method for multilingual global editing utilizing a network. The text in a first language from a first user is translated to a second language and sending to a second user utilizing the network. Hohl (U.S. Pub. No. 2002/0137012 A1) discloses the programmable electronic self-teaching audio device. Hon et al (U.S. Pat. No. 6,490,563 B2) teaches the system and method for proofreading text to speech feedback. Agarwal et al (U.S. Pat. No. 6,509,910 B1) discloses the method and system for interfacing with a digital media frame network for sharing data in the network. Hall (U.S. Pat. No. 6,575,468 B1) teaches the method and apparatus for playing the word game through the Internet. Rehbein et al (U.S. Pub. No. 2004/0083111 A1) teaches the method and apparatus for performing a translation without the use of spoken communication between the transaction parties.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (571)272-4433. The examiner can normally be reached on Tue. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571)272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joe H. Cheng
Primary Examiner
Art Unit 3715

Joe H. Cheng
June 22, 2006